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10/728,160	12/04/2003	Puthukode G. Ramachandran	AUS920030976US1	6788

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EXAMINER

LEE, JINHEE J

ART UNIT	PAPER NUMBER
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2174

MAIL DATE	DELIVERY MODE
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07/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/728,160	Applicant(s) RAMACHANDRAN, PUTHUKODE G.	
	Examiner Jinhee J. Lee	Art Unit 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>0207</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "responsive to " in line 8. This is confusing. What is responsive to, Clarify.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Re claim 1-20, claim 1-20 claims a data structure or method, however, it appears the limitations of said claim are merely claiming statements defining various items, therefore said limitations do not appear to be defining any functional interrelations which permits the computer program's functionality (or data structure's functionality) to be realized.

In view of the above, claims 1-20 are therefore directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Sylor et al. (20020186238).

Re claim 1, Sylor et al. discloses a method in a data processing system for managing display of a new document, the method comprising:

Displaying, in response to receiving a user input indicating that the new document is to be displayed, a list of browser windows including an indication of a presently displayed document in each respective browser window in the list of browser windows (see paragraph 0152 and 0177, title bar for example); and

responsive to a user selection of a browser window from the list of browser windows, replacing a document displayed in the browser window with the new document (see paragraph 0177 and figure 6B for example).

Re claim 2, Sylor et al. discloses a method further comprising: promoting the browser window to a top of a window hierarchy (see paragraph 0177 and 0152 for example).

Re claim 3, Saylor et al. discloses a method, wherein the indication is a document name from a title bar (see paragraph 0101 for example).

Re claim 4, Saylor et al. discloses a method, wherein the indication is a thumbnail of the document (see paragraph 0102 for example).

Re claim 5, Saylor et al. discloses a method, wherein the list of browser windows, including the indication of the presently displayed document in each respective browser window in the list of browser windows (recent lists, see paragraph 0152 for example), is displayed in a pop-up menu (see paragraph 0152, 0177 and figure 6b for example).

Re claim 6, Saylor et al. discloses a method, wherein the receiving step and the replacing step are performed by a Web browser (see paragraph 0152, 0177 and figure 6b for example).

Re claim 7, Saylor et al. discloses a method, wherein the new document is selected from one of a Web page, an image, or a spreadsheet(see paragraph 0152, 0177 and figure 6b for example).

Re claim 8, Saylor et al. discloses a method, wherein the user input is received in a currently active browser window(see paragraph 0152, 0177 and figure 6b for example).

Re claim 9, Saylor et al. discloses a data processing system for managing display of a new document, the data processing system comprising:

displaying means, responsive to receiving a user input indicating that the new document is to be displayed, for displaying a list of browser windows including an

indication of a presently displayed document in each respective browser window in the list of browser windows; and

replacing means, responsive to a user selection of a browser window from the list of browser windows, for replacing a document displayed in the browser window with the new document(see paragraph 0152, 0177 and figure 6b for example).

Re claim 10, Sylor et al. discloses a data processing system further comprising: promoting means for promoting the browser window to a top of a window hierarchy(see paragraph 0152, 0177 and figure 6b for example).

Re claim 11, Sylor et al. discloses a data processing system, wherein the indication is a document name from a title bar(see paragraph 0152, 0177 and figure 6b for example).

Re claim 12, Sylor et al. discloses a data processing system, wherein the indication is a thumbnail of the document(see paragraph 0152, 0177 and figure 6b for example).

Re claim 13, Sylor et al. discloses a data processing system, wherein the list of browser windows, including the indication of the presently displayed document in each respective browser window in the list of browser windows (recent list, see paragraph 0152 for example), is displayed in a pop-up menu (see paragraph 0152, 0177 and figure 6b for example).

Re claim 14, Sylor et al. discloses a data processing system, wherein the receiving means and the replacing means are performed by a Web browser(see paragraph 0152, 0177 and figure 6b for example).

Re claim 15, Sylor et al. discloses a computer program product comprising:
first instructions, responsive to receiving a user input indicating that the new document is to be displayed, for displaying a list of browser windows including an indication of a presently displayed document in each respective browser window in the list of browser windows(see figure 6b with 519 for example); and

second instructions, responsive to a user selection of a browser window from the list of browser windows, for replacing a document displayed in the browser window with the new document(see figure 6b with 518 for example).

Re claim 16, Sylor et al. discloses a computer program product further comprising: third instructions for promoting the browser window to a top of a window hierarchy(see paragraph 0152, 0177 for example).

Re claim 17, Sylor et al. discloses a computer program product, wherein the indication is a document name from a title bar(see paragraph 0101 for example).

Re claim 18, Sylor et al. discloses a computer program product, wherein the indication is a thumbnail of the document(see paragraph 0102 for example).

Re claim 19, Sylor et al. discloses a computer program product, wherein the list of browser windows, including the indication of the presently displayed document in each respective browser window in the list of browser windows (recent list, see paragraph 0152 for example), is displayed in a pop-up menu (see paragraph 0152, 0177 and figure 6b for example).

Re claim 20, Sylor et al. discloses a computer program product, wherein the first instructions and the second instructions are performed by a Web browser (see paragraph 0152, 0177 for example).

Re claim 21, Sylor et al. discloses a data processing system comprising:

a bus system (with 635 for example);

a memory (with 634 for example) connected to the bus system, wherein the memory includes a set of instructions; and

a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to receive a user input indicating that a new document is to be displayed, wherein a list of browser windows is displayed including an indication of a presently displayed document in each respective browser window in the list of browser windows; and replace a document displayed in the browser window with the new document in response to a user selection of a browser window from the list of browser windows(see paragraph 0152, 0177 and figure 6b for example).'

Response to Arguments

7. Applicant's arguments filed 4/30/07 have been fully considered but they are not persuasive.

In response to applicant's arguments that 101 requirements are met, examiner disagrees. An apparatus claims need to have an hardware to establish a statutory category, and if the claims are for programmed functionality, then a physical transformation or a useful, concrete and tangible final result. Method claims likewise need a physical transformation or a useful, concrete and tangible final result and

hardware reference. The claims are lacking in the requirements, therefore have not met the statutory requirement.

In response to applicant's arguments that the prior art does not teach of "a new document" to be displayed, examiner disagrees. The applicant has argued that clicking on "NEW" button in the prior art would preclude from meeting the claim language, however, examiner points out that applicants invention does not require clicking on "New" button. The applicant's inventions meaning of "new" seems to refer to a document that is different from the current document (and including the current document) in their step of selecting "new document". The "recent lists" option in the prior art, as described in paragraph 0152, meets the claim requirement as claimed.

In response to applicant's argument that the prior art does not teach of "thumbnail of the document", examiner disagrees. Paragraph 0102 describes "text identifying client application 22 ", which describes the document, i.e. thumbnail of the document.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

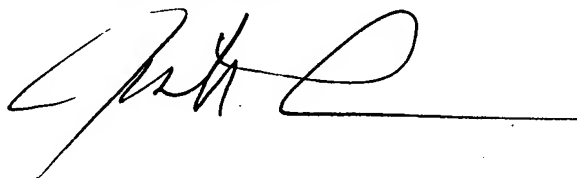
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J. Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M-F at 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 571-272-2100 ext. 74. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jinhee J Lee
Primary Examiner
Art Unit 2174

jjl

A handwritten signature in black ink, appearing to be 'Jinhee J. Lee', written over a horizontal line.